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In The

Supreme Court of the United States

OCTOBER TERM 2006

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IN RE LEONARD R. KAHN,

Petitioner.

PETITION FOR A WRIT OF MANDAMUS

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QUESTIONS PRESENTED

Question 1

When the Federal Circuit identified as its key reason for denying Appellant Kahn a patent was that his claims were obvious under 35 U.S.C. §103 because Kahn had not provided secondary evidence of *long-felt but unresolved needs* for his reading machine for the blind, (20a), was it not error that the Federal Circuit refused (46a) to consider a timely offered amicus brief which affirms said "need" when the author of the amicus brief is an independent acknowledged expert on the blind?

Question 2

Given the facts stated in question 1, did the Federal Circuit deny Kahn his Fifth Amendment constitutional right to Due Process by refusing to follow Rule of Evidence 201 and did not the Court violate Kahn's first amendment constitutional right to petition his government as per *Lebron v. National Railroad Passenger Corporation,* 513 U.S. 374, 392 (1995) when it refused to consider the timely filed petitions to file an amicus brief?

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STATEMENT OF THE CASE

The appeal to the Federal Circuit involves review of Appellant Kahn's patent application serial no. 08/773,282, (the '282 application), filed Dec. 24, 1996. In a decision dated June 30, 2004, the Board affirmed the examiner's rejection of claims 1-20 of the '282 application under 35 U.S.C. §103 in view of a combination of four references (1) Stanton, U.S. Patent No. 4,322,744, (Stanton '744), issued March 30, 1982 (APTO 0249); (2) Anderson, et al., U.S. Patent No. 4,406,626 (Anderson '626), issued Sept. 27, 1983 (APTO 0251); (3) Anderson et al., U.S. Patent No. 4,579,533 (Anderson '533); issued April 1, 1986 (APTO 0288); and (4) Garwin et al., U.S. Patent No. 4,595,990 (Garwin '990), issued June 17, 1986 (APTO 0302). The Board also affirmed its own rejection of claims 21 and 22 under 35 U.S.C. §112, ¶1 as non-enabled. (APTO 0227)

The Appellant filed a timely notice of appeal to the Federal Circuit on Sept. 28, 2004. Kahn filed more than one motion to obtain the official PTO file wrapper all of which the PTO opposed. The Court denied Kahn's motions based upon the PTO statement that Kahn's request was for "long abandoned" applications. Kahn has still never received certain wrapper documents from the PTO.

Prior to the PTO publishing full details of the final CIP Kahn '282 patent application and Kahn's further assumed secret correspondence with the Examiner and the PTO Board the Appellant filed an "Unopposed Motion to Dismiss and to Place Certain Court Documents Under Seal" on June 21, 2005, asking this Court to seal all documents not already made public. The PTO, before the Court acted on Kahn's motion, placed in public files its Appendix including the complete subject patent application. Since these motions are not material to this writ, the petitioner, with the court's permission will not further burden the record. The case was fully briefed and a 21 page decision was issued affirming the PTO decision. Kahn filed a motion to submit an amicus brief, (5/18/06) it was denied as was the Kahn petition for *en banc* rehearing.(49a)

JURISDICTIONAL STATEMENT

The order of the United States Court of Appeals for the Federal Circuit sought to be reviewed was entered May 31, 2006.(46a) An order denying a timely petition for rehearing *en banc* was similarly entered May 31, 2006.(46a) The petition for a writ of mandamus was filed within 90 days thereafter.

Pursuant to Rule 20.1 this Court has jurisdiction to

review an extraordinary writ of mandamus because the opinions or orders of a circuit court will allegedly cause irreparable harm absent prompt action by this Honorable Court.

As to the specific wording in Rule 20, a grant of the instant writ would; "aid in the Court's appellate jurisdiction" so that when the writ is carried out, Kahn can file a petition for certiorari so this Court could consider whether the Federal Circuit followed the Administrative Procedure Act and this Court's teachings in *Dickson v. Zurko,* 527 U.S. 150 (1999) and the Federal Circuit's own decision, *In re Lee* 277 F. 3d 1338 (Fed. Cir. 2002).

The importance of the Federal Circuit's interpretation of *Zurko* is underscored by University of Chicago Prof. Dennis Crouch, who stated, in his 3 page analysis of this specific case: "*In re Kahn... I already provided a summary of this... opinion, but decided that the meat of the opinion is important enough to be repeated...* "

Also, if this writ is granted Kahn will be in a position to appeal the important split in the Circuits re the treatment of patent applications as confidential matter.

REASONS FOR GRANTING A WRIT OF MANDAMUS

I. INTRODUCTION AND BACKGROUND

Except for a number of time consuming procedural problems, this case presents a simple question: Does a device that permits totally blind individuals to "read" and understand serious documents, such as legal briefs and scientific papers, as fast as most sighted individuals satisfy *long-felt but unresolved needs*?

Appellant Kahn argued the importance of this invention in writing the original parent 1989 application to satisfy a basic long felt need in allowing totally blind individuals to earn a good living. This "*long-felt need*" question formally became the case's key issue over a decade ago when the PTO Board, as the Federal Circuit stated in its final Opinion:

> *In its 1995 decision, after reversing the examiner's anticipation rejection, the Board sua sponte rejected the relevant claims under §103.*

Opinion March 22, 2006, page 6

This 1995 *sua sponte* ruling by the PTO Board also set up a "Catch 22" situation.

The Board's obviousness §103 decision denied Kahn an

examination by an Examiner who could make an independent ruling on the obviousness question. The Examiner could not overrule the Board, no matter what evidence Kahn would offer.

Thus, the Board, by its *sua sponte* decision, denied Kahn his Fifth Amendment Right to Due Process and set up the failure of the 17 year prosecution, wherein the Federal Circuit found that Kahn had not provided evidence for it to take Judicial Notice of what is now central to this case... That the invention obviously satisfies *long-felt needs*.

And after finding the first Examiner's §102 rejection to be in error, the Board should have sent the case back for an examination as to whether or not the invention was obvious under §103. This would have permitted Kahn to convince the Examiner that claims 1 to 20 were not obvious. (In order to simplify the appeal, Kahn did not appeal Claims 21 and 22.) If Kahn had been successful with the examination, he would have, assuming that Kahn complied with all other requirements (as the Board apparently found) been issued a patent.

For the Board to have argued that there was no proof of "*long felt need*" violates common sense, and for the PTO to use its own flawed procedures to later claim that Kahn must be blocked from proving "*long-felt but unresolved needs*" represents a CATCH 22 situation which resulted in the Board's denial of the grant of a patent most useful to blind individuals.

Furthermore, since one of the key advantages of the subject invention is that it replaces the mouse with a vastly

superior human/computer interface, we can consider whether the mouse's conception in 1964, sets the "*long standing need*" to at least 40 years. Surely the Court can take judicial notice that eye control is superior to dragging a mouse.

II. THIS PETITION IS LIMITED TO THE FEDERAL CIRCUIT'S DENIAL OF CONSIDERATION OF AN AMICUS BRIEF

But this petition for a writ of mandamus is limited to a request for the Federal Circuit to be ordered to consider the timely filed amicus brief, and the actions of the PTO Board only serve as background in explaining why support for taking judicial notice was not permitted early into the case and, indeed, why a patent wasn't issued at least a decade ago.

However, even if the case did not treat a split of circuits, and failure of the Federal Circuit to follow *Dickson v. Zurko,* 527 U.S. 150 (1999) the Federal Circuit's own *In re Lee* 277 F. 3d 1338 (Fed. Cir. 2002) and the APA, the denial of consideration of the amicus brief violates Kahn's basic constitutional rights.

In order to avoid prolix, Kahn, with the permission of the Court, wishes to use questions that were drafted before he decided to restrict this appeal to the one issue; the consideration of a timely filed amicus brief by an independent expert. The

following "discarded questions" hopefully provide useful background information:

III. DISCARDED QUESTIONS PROVIDE USEFUL BACKGROUND

Discard Question 1 since Evid. Rule 201(d) made it mandatory for the Federal Circuit to take judicial notice when Kahn requested an opportunity to file a timely 201(f) request that the Court take notice that the subject invention was not obvious and offered objective indicia evidence from an independent amicus curiae, expert in the field of blindness, did the Court err by refusing to reconsider its original March 22, 2006 decision:

"*Finally, we note Kahn had an opportunity to rebut the Board's prima facie case by offering evidence of objective indicia of non-obviousness.. [he now] invites this court to take "judicial notice" of the long-felt but unresolved need. We must decline [sic] Khan's invitation...?*"

Discard Question 2 additionally, didn't the PTO Board commit error when Kahn was never permitted to submit vital evidence during the 16 year prosecution of his application as a result of the Board finding *sua sponte* that the submitted claims were obvious under 35 U.S.C. §103, thus making the Examiner powerless to find the patent claims allowable as it would require

her to overrule the Board (beyond her authority) and, therefore, wasn't Kahn denied the opportunity to introduce evidence of *long-felt but unresolved needs,* in clear disregard of Due Process and *Dickson v. Zurko,* 527 U.S. 150 (1999)?

Discard Question 3 recognizing that the three Judge panel was requested to review serious alleged errors by one of the Judges, including the refusal to permit Kahn access to his own patent file wrapper to prove entitlement to his 1989 filing date and that this same Judge ruled that Kahn's priority date was 1996 costing him 7 years, which the panel 16 months later overruled, and then this same Judge authored the March 22, 2006 Opinion that is the basis of the instant petition for a writ of mandamus and that this same Judge, on information and belief denied Kahn's request for an oral hearing and most importantly on information and belief denied consideration of the amicus brief, did not said Judge's failure to recuse himself violate the action of Chief Justice Roberts in *Guantanamo Detainees* --- U.S ---, (2006)

IV. THE PETITIONER SEEKS EMERGENCY RELIEF IN ORDER FOR THE PUBLIC AND, MOST IMPORTANTLY, THE BLIND TO MAKE USE OF THE SUBJECT INVENTION AT THE LOWEST COST

Unfortunately the Solicitor immediately, after Kahn

moved for the Federal Circuit to seal crucial technical documents as part of an unopposed motion to have the appeal dismissed, placed in public files the very files Kahn wanted sealed. The Solicitor's action made the dismissal agreement unacceptable to Kahn and Kahn successfully moved to recall the mandate. However, the Solicitor's premature action made public Kahn's trade secret information so that firms wishing to develop such reading machines could easily copy Kahn's basic technology. Until these firms finish their developments and promote their new products it is impossible for Kahn to guess how many products will be introduced and the quality of such products.

However, Kahn can affirm that if he is granted the instant writ he will, as is his normal custom when he expects a patent to issue, consider possible improvements and even the possible filing of a new CIP application. Assuredly, since the Appellant considers this invention to be from a humane viewpoint, the most important of his over 80 U.S. issued patents and, accordingly, he can be expected to make improvements that the putative copyists would not know about. Thus, inferior products would be expected to be sold by copyists to the blind.

Also, importantly Kahn affirmed in his petition for rehearing en banc page 14 that he would not impose a royalty on any reading machines sold to any legally blind individuals who

purchase them for his or her own use. And much more importantly, Kahn also reaffirms that he would not license manufacturers who do not agree to only manufacture reading machines that allow legally blind people to use them "out of the box" without any special additional hardware or software. People who are knowledgeable in the field of helping the blind, such as Amicus Curiae Dall, can confirm that even small add-on devices can greatly increase the final cost of the overall price of equipment for blind users.

Thus, it is highly improbable that firms that rush to market copying other peoples' technology would have such concerns.

CONCLUSION

For the above stated reasons this petition requires emergency relief for the sake of the Appellant, possible entities making use of the published technical information and, by far most importantly, blind individuals.

Dated: August 23, 2006

Respectfully submitted,

Leonard R. Kahn
Appellant, *pro se*

No. 06-

In The

Supreme Court of the United States

OCTOBER TERM 2006

IN RE LEONARD R. KAHN,

Petitioner.

APPENDIX

SW

St. Louis West, Inc.

Appendix A – Decision of the United States Court of Appeals for the Federal Circuit, Dated March 22, 2006 [Pages 1a – 33a]

United States Court of Appeals for the Federal Circuit

04-1616

(Serial No. 08/773,282)

IN RE LEONARD R. KAHN

DECIDED: March 22, 2006

Before MICHEL, Chief Judge, LINN, and PROST, Circuit Judges.

LINN, Circuit Judge.

Leonard R. Kahn ("Kahn") appeals from the final decision of the Board of Patent Appeals and Interferences ("Board") concluding that claims 1-20 in patent application number 08/773,282 ("the '282 application") are unpatentable as obvious under 35 U.S.C. § 103.[1] Because the factual findings underlying the Board's conclusion are supported by substantial evidence, and because the Board did not commit

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[1] The Board also affirmed its own rejection of claims 21 and 22 as being non-enabled under 35 U.S.C. § 112, ¶1; however, in his opening brief on appeal Kahn withdrew those claims, leaving only claims 1-20 before us.

legal error in concluding that the claims would have been obvious, we affirm.

I. BACKGROUND

A. The Invention

The '282 application, filed on December 24, 1996 as a continuation-in-part of a series of continuing applications dating back to 1989, involves a "reading machine" that may be used by the blind. Prior to the application, machines that employed memory and display components by which material could be "read" using hand-held optical pens and speech synthesizers were known in the art. While a user can control these devices by hand to repeat words and to read at various speeds, such control is cumbersome, which makes it difficult for a blind user to study complex publications. Kahn addressed this problem and claims invention in a device that is operated by eye control and sound localization such that it can read out loud the word "looked at" by the user.

Kahn treats claims 1-20 as a group with claim 1 being representative:

> 1. A reading machine suitable for use by totally blind individuals for

reading the complete text, or a selected portion thereof, of a document stored in storage means, at the option of the user, comprising.

(a) means of storing at least a portion of the text of the document to be read,

(b) means for retrieving a selected portion of said stored text made available for immediate "reading,"

(c) means for producing an acoustical display of the selected portion of said stored text, in a page-like format,

(d) means for determining the location on the acoustical display towards which the user is "looking," and

(e) means for generating speech sounds verbalizing the word that is formatted to appear on the acoustical display at the location the user is "looking" towards.

A preferred embodiment of the '282 patent is illustrated below in Figure1. (See next page)

Appendix A
[Decision of the USCA for the Federal Circuit]

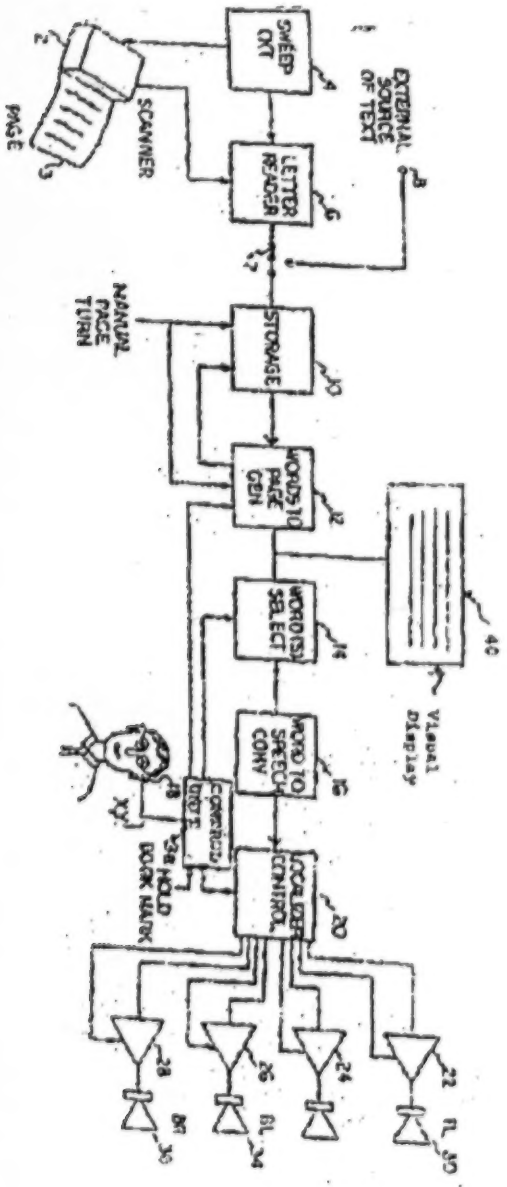

FIG. 1

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In operation,

> [t]he information being "read". . . is fed through intermediate storage means to speech synthesizer means for converting the written information to electrical waves representing speech sounds. These electric waves are fed to . . . a four speaker array wherein the speakers are located in a fashion so that the artificial sound image can be placed at various points on the artificial screen or page allowing the user to hear the words at the desired locations. These locations would be selected by the user looking at a specific location on the artificial screen or page.
>
> The user would then move his or her eyes to "look" where the next word would be expected to appear, i.e., directly to the right of the spoken word. This would then cause the next word to be "spoken" and the sound image would appear slightly to the right. This motion is achieved by energizing the four speaker array with different levels of audio power. . . .
>
> When the user completes the "reading" of the last word on the page,. . . the reader would have the option of rereading a section on the page or

> causing the page to be "turned." If the user wishes to reread . . . , he can direct his attention to the material to be reread by "looking" at the portion of the page where he remembers hearing the material.
>
> On the other hand, if he wishes to continue reading the material he can turn the page by looking along the bottom line past the right hand edge of the "page". The first word on the new page would be heard when the reader directed his or her attention to the upper left hand corner of the page where the first word on the new page would be expected.

'282 application at 11-13.

According to the specification, the device can employ a conventional scanner to input data; a conventional character recognition device to translate and send data to a storage device; and a page generator to take data from the storage device and format it for a visual display and for a word selector, the latter of which can send the data to a conventional speech synthesizer. After an optical sensor detects where a user is "looking" and a word is "selected" for vocalization, the synthesizer feeds an audio signal to a localizer control. Loud speakers are arranged at the corners of

the "page" to allow the user to confirm localization of sound. The specification further indicates that

> [t]here are a number of devices available for sensing where an individual is looking. For example, Garwin et. al. 4,595,990. . . , Anderson et. al. 4,579,533. . . and Stanton 4,322,744 More specifically, Anderson's [sic] patent discusses feed-back which may be visual, auditory or tactile to verify decisions by eye control equipment.
>
> However, such inventions are not suitable for totally blind individuals who are not verifying where they are looking but are using their eyes to direct which part of the artificial page should be read to produce a sound image. This makes essential a two dimensional stereo sound stage which the blind person solely depends upon.

'282 application at 16.

B. The Prior Art

The Board's rejection was based on Garwin et al., U.S.Patent No.4,595,990 (issued June 17, 1986) ("Garwin"), in view of Anderson et al., U.S. Patent No. 4,406,626 (issued Sept. 27, 1983) ("Anderson '626"), Anderson et al., U.S. Patent No 4,579,533 (issued April 1, 1986) ("Anderson

'533"), and Stanton, U.S. Patent No. 4,322,744 (issued March 30, 1982) ("Stanton"). The Board alternatively used Anderson '626 or '533 as primary references.

Garwin discloses an eye-controlled interactive information processor that senses the portion of a visual display at which the user is looking. The processor is connected to the display, which, in turn, can be partitioned so that different information is displayed in discrete areas. By gazing in different directions, the user informs the processor of the displayed item that is selected Garwin, col. 2, ll. 60-68. The preferred embodiment employs a reflected light eye-tracking device to determine where the user is looking. Id., col. 3, l. 66-col. 4, l. 62" The eye-interactive control generally uses a technique where the user is presented with a number of targets having some meaning, such as "words or phrases" displayed on screen. Id., col. 9, ll. 62-67. "Visual, auditory or tactile" feed back is then given to the user to indicate that a selection has been received. Id.,col.2, ll. 10-11; col. 11, ll. 59-64. The user then can verify or cancel the selection. Id., col. 10, ll. 1-6. Garwin states that "it will be apparent to one skilled in the art that. . . the benefits of the invention will be achieved by many types of apparatus." Id., col. 2, ll. 50-53. It

can be used for "request[ing] display of a page of text from a . . . table of contents," id., col. 3, ll. 42-44, or "[other] presentation of textual material," id., col. 10, ll.31-33.

Anderson '626. Anderson discloses an interactive "electronic teaching aid" which enables a user viewing text on a display to designate any words or portion of text for immediate audible vocalization. Anderson '626, col. 1, l. 8; col. 2, ll. 11-17. The components include: a selector switch, which when in the "text" position, causes data to be transmitted to a monitor and displayed in legible form, id., col. 3, 11.27-31; an advance button, which when depressed allows the user to select and retrieve the next page of text from memory, id., col. 3, 11.31-41; a memory, which can store each word of the text coded for speech, id., col. 3, l.66-col. 4,l.6; and a word designator light pen, which the user can place on a word to hear the word vocalized through the speaker, id., col. 3, ll. 54-68; col. 10, ll. 51-58. Anderson '533 discloses an improved microprocessor-based version of Anderson '626. Anderson '533, col. 1, ll. 19-24, 41-56.

Stanton discloses an acoustical imaging system for use by visually impaired individuals that uses horizontal and vertical directional sound to represent visual aspects of an

environment. Stanton states that a user can locate "the position of a virtual sound source as representing a point in space" such that different signals may represent different directions. Stanton, col. 1, ll. 58-61. The preferred embodiment features four loud speakers or transducers mounted at the corners of a vertical display panel. Id., col.2, ll. 54-55. When the user moves the cursor, the sound emanating from the speakers is phase shifted to produce a virtual sound seeming to come from a particular location related to the position of the cursor. Id., col.1, l. 66-col. 2, l. 2; col. 2, ll. 55-63. In another embodiment, a quadraphonic headset is used in place of the transducers to achieve the effect of producing a virtual sound identifying a position. Id., col. 4, ll. 26-35. Stanton states that the device may be used as a "rudimentary reading device". Id., col. 1, ll. 62.

C. The Board Decisions

Kahn filed the '282 application with 22 claims as a continuation-in-part of application number 07/645,102 ("the '102 application"), which was filed in 1991. The '102 application was a continuation-in-part of a series of abandoned continuing applications dating back to application number 07/338, 597, which was filed in 1989. While claims

21 and 22 of the '282 application are not at issue in this appeal, the Board addressed those claims on several occasions, which led to the creation of a substantial Board history. As a result, the final decision with respect to the obviousness rejection of claims 1-20 spans three decisions, which include Ex Parte Kahn, No. 2004-1091 (B.P.A.I. June 30, 2004) ("2004 decision"); Ex Parte Kahn, No. 2000-1130 (B.P.A.I. Feb. 24, 2003) ("2003 decision"); and Ex Parte Kahn, No. 94-2233 (B.P.A.I. Sept. 21, 1995) ("1995 decision").

In its 1995 decision, after reversing the examiner's anticipation rejection, the Board sua sponte rejected the relevant claims under § 103. The Board found that Garwin taught "the concepts of determining where on a display screen a user is 'looking' ... and giving either visual or auditory feedback to the user" and that"[w]hile nothing specific is said as to acoustically reproducing a word displayed at that location, common sense..... indicate[s] that such an auditory feedback response is appropriate in view of such auditory feedback confirmation clearly suggested by Anderson '533 or '626." 1995 decision, slip op. at 5 (emphasis in original). The Board found that "to whatever extent Garwin is not concerned

with text per se, [the Anderson] references are" and "teach the advantages of text display with audio reproduction," concluding that

> the artisan would have found it to have been obvious to have modified Garwin for display of text passages and selection of works therefrom with vocalization thereof as feedback confirmation, all as taught by Anderson '626 '533 ... [or] to have modified either of these Anderson references to use the eye control of Garwin so that the user's hands would have been free for other tasks.

Id., slip op. at 5-6. The Board found that Stanton "teaches the benefit of acoustic imaging in reading systems" and that "[i]t would have, thus, been further obvious to the artisan to add advantageous acoustic imaging to either of the above-noted modified devices of Garwin or the Anderson patents which would have word positions acoustically and visually indicated." Id., slip op. at 6.

In its 2003 decision, the Board expressly incorporated the findings and rationale from both its 1995 decision and the Examiner's Answer filed on April 24, 2000. 2003 decision, slip op. at 3-4. In the Answer, the Examiner had explained

that Garwin teaches "a buffer memory which stores at least a portion of the information derived from sensing means and means for subsequently retrieving the sensed information," "means for displaying stored written text," and "means for determining which word of the displayed text the user is looking towards"; that Anderson '626 teaches "means for generating speech sounds verbalizing the looked at word"; and that Stanton teaches "means for verbalizing each word the user's eyes are directed towards in two dimensional stereo." Examiner's Answer at 5-6. Rejecting Kahn's argument that hindsight drove the combination of references, the Board reiterated that the rationale of the 1995 decision was correct and explained that motivation "clearly is based upon a prospective look at the state of the art." 2003 decision, slip op. at 8-11

The Board addressed several other arguments. First, the Board rejected the argument that the invention's intended use supports patentability, noting that "the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus [from] a prior art apparatus satisfying the claimed structural limitations. "Id. at 5-6. Second, the Board rejected the argument that because

"the purposes of the [prior art] references…are different from the [invention's] purpose." the invention is non-obvious, explaining that "[t]he law. . . does not require that references be combined for reasons contemplated by an inventor" and that "prior art need not suggest the same problem set forth by appellant." Id. at 6-7. Third, the Board rejected the arguments that features of a secondary reference be capable of incorporation into the structure of a primary reference and that the invention be suggested completely by one reference. Id. at 7. Finally, the Board rejected a "long-felt need" argument, explaining that Khan had not presented any objective evidence of a long-standing problem or long-standing need in the art. Id. at 11-12.

In its 2004 decision, the Board entered a final rejection of claims 1-20 based on its 2003 decision. Kahn timely appealed to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

II. DISCUSSION

A. The Parties' Arguments

Khan advances two main arguments. First, Khan asserts that the Board's finding of motivation to combine was

unsupported by substantial evidence. Citing In re Lee, 277 F.3d 1338 (Fed. Cir. 2002), and In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998), Khan argues that the Board overstated the knowledge of the skilled artisan and employed improper hindsight. Specifically, Khan assets that a skilled artisan would not have sought to augment Garwin with sound because the resulting device would be more expensive and less reliable for the purpose intended by Garwin. He contends that just because Stanton teaches use of sound to confirm a visual perception of a shape like a letter—which provides a "rudimentary" reading capability--does not mean that the reference teaches how to enable a blind user to "read" and "reread" entire words and phrases quickly. Khan further contends that Stanton teaches away from a system that employs iris eye direction sensing because Stanton requires the user to hold his head steady, because eyes are not involved in its localization procedure, and because the combined device would be expensive and inoperable. Second, Khan argues that the court should take "judicial notice" that his reading machine addresses a "long-felt, but unresolved need," and that this consideration is insufficient to rebut a prima facie case of obviousness.

The Patent and Trademark Office ("PTO") counters that Lee and Rouffet are distinguishable because here the Board identified motivations to combine the references based on specific statements in the references and on the nature of the problem to be solved. As to long-felt need, the PTO argues that Kahn proffered no actual evidence, and that Kahn's argument alone is insufficient to rebut a prima facie case.

B. Standard of Review

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art. 35 U.S.C. § 103(a) (2000); Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966).The ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact. In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). We review the Board's ultimate determination of obviousness de novo. Id. However, we review the Board's underlying factual findings, including a finding of a motivation to combine, for substantial evidence. In re Gartside, 203 F.3d 1305, 1316

(Fed. Cir. 2000).

Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. Id. at 1312 (citing Consol. Edison Co. v. NLRB, 305 U.S. 197, 229-30 (1938)). It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. Consol. Edison, 305 U.S. at 229-30. In reviewing the record, we must take into account evidence that both justifies and detracts from the factual determinations. Gartside, 203 F.3d at 1312 (citing Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88 (1951)). We note that the possibility of drawing two inconsistent conclusions from the evidence does not prevent the Board's findings from being supported by substantial evidence. Id. Indeed, if a reasonable mind might accept the evidence as adequate to support the factual conclusions drawn by the Board, then we must uphold the Board's determination. Id.

C. Analysis

In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in Graham v. John Deere Co. The Board determines "'the scope and content of the prior art,'"

ascertains "'the differences between the prior art and the claims at issue,'" and resolves "'the level of ordinary skill in the pertinent art.'" Dann v. Johnston, 425 U.S. 219, 226 (1976) (quoting Graham, 383 U.S. at 17). Against this background, the Board determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention. Graham, 383 U.S. at 17. In making this determination, the Board can assess evidence related to secondary indicia of non-obviousness like "commercial success, long felt but unresolved needs, failure of others, etc." Id., 383 at 17-18; accord Rouffett, 149 F.3d at 1355. We have explained that

> [t]o reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness...On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.

Rouffett, 149 F.3d at 1355.

Most inventions arise from a combination of old elements and each element may often be found in the prior

art. Id. at 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. Id. at 1355, 1357. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. Id. In practice, this requires that the Board "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. "Id. at 1357-59. This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test.

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. Id. at 1358. The "motivation–suggestion–teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. See

35 U.S.C.S § 103 (stating that obviousness must be assessed" at the time the invention was made"); Dembiczak, 175 F.3d at 998 ("[I]t is this phrase that guards against entry into the tempting but forbidden zone of hindsight." (internal quotations omitted)); Giles S. Rich, Laying the Ghost of the Invention Requirement, 1 APLA Q.J. 26-45 (1972), reprinted in 14 Fed Cir. B.J.163, 170 (2004). ("To protect the inventor from hindsight reasoning, the time is specified to be the time when the invention was made.") (emphasis in original). The Supreme Court recognized the hindsight problem in Graham and proposed that "legal inferences" resulting from "secondary considerations" might help to overcome it. 383 U.S. at 36. ("[Secondary considerations] may also serve to guard against slipping into use of hindsight, and to resist the temptation to read into the prior art the teachings of the invention in issue." (internal quotations omitted)). By requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight in all cases—whether or not the applicant offers evidence on secondary considerations—which advances Congress's goal of creating a more practical, uniform, and definite test for patentability. See Dann, 424 U.S. at 225-26

("[I]t was only in 1952 that Congress, in the interest of 'uniformity and definiteness,' articulated the requirement in a statute." (quoting S. Rep. No. 1979, at 6 (1952); H.R. Rep. No. 1923, at 7 (1952))); Graham, 383 U.S. at 17 ("The § 103 [test], when followed realistically, will permit a more practical test of patentability.").

Although our predecessor court was the first to articulate the motivation-suggestion-teaching test, a related test--the "analogous art" test--has long been part of primary Graham analysis articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35.[2] The analogous-

[2] In Graham, Cook Chemical challenged the court's reliance on a reference that it believed was not in a "pertinent prior art," arguing that while the invention involved a container having a "pump sprayer," the reference related to containers having "pouring spouts." 383 U.S. at 35. In reaching the conclusion that the claimed subject matter was obvious, the Court rejected Cook's argument, explaining that the problem to be solved was a mechanical closure problem and that a closure device in such a closely related art was a pertinent reference. Id. Similarly, in Dann, the invention involved the use of automatic data processing equipment to analyze transactions within a single bank account. 425 U.S. at 227-28. The Dirk reference that the Court relied upon in making its obviousness case involved a similar system used in a non-banking context. Id. at 228. Citing Graham, the Court explained that a person of ordinary skill in the art would be aware of this reference and the Court could rely upon it in making its obviousness case because "[w]hile the Dirk's invention is not designed specifically for application to the banking industry many of its characteristics and capabilities are similar to those of respondent's system." Id. at 229.

art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. ("[I]t is necessary to consider 'the reality of the circumstances,'–in other words, common sense–in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See id.; In re Clay, 966 F.2d 656, 059-60 (Fed. Cir. 1992).[3]

[3] In In re Clay, we reasoned that

> [i]f a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); Graham, 383 U.S. at 35; Dann, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as

> The teaching, motivation, or

> when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

966 F.2dat 659-60. In In re Oetiker, we held that "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." 977F.2d at 1447.

> suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.. . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.

In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (internal citations omitted). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett 149 F.3d at 1355-59. This requirements is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in § 103. See id. at 1344-45.

In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 424 F.3d

1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); Ecolochem, Inc. v. S. Cal. Edison Co.,227 F.3d 1361 1372 (Fed. Cir. 2000) ("Although the suggestion to combine references may flow from the nature of the problem, '[d]efining the problem in terms of its solution reveals improper hindsight of in the selection the prior art relevant to obviousness.'" (internal citation omitted) (quoting Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed.Cir.1998))); In re Beattie, 974 F.2d 1309, 1312 (Fed.Cir.1992) ("[T]he law does not require that the references be combined for the reasons contemplated by the inventor."); Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (characterizing the relevant inquiry as"[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention,[] have selected the various elements from the prior art and combined them in the manner claimed"); see also Graham, 383 U.S. at 35 (characterizing the problem as involving mechanical closures rather than in terms more

specific to the patent in the context of determining the pertinent prior art). Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See Cross Med. Prods., 424 F.3d at 1321-24. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art –i.e., and the understandings knowledge of persons having ordinary skill in the art at the time of the invention–support the legal conclusion of obviousness. See Princeton Biochemicals, 411 F.3d (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).

In this case, Khan does not dispute that each element of his claimed invention can be found in either Garwin, Anderson '533 and '626, or Stanton, or that each reference lies in the pertinent art. Nor does Khan take issue with the Board's finding that a person having ordinary skill in the art

would have been motivated to modify Anderson '533 or '626 in view of Garwin, or vice versa. See Garwin, col. 2, ll. 50-53, col. 10, ll. 31-35 (stating that "it will be apparent to one skilled in the art that.... the benefits of the invention will be achieved by many types of apparatus" which may be "virtually [any device] susceptible of control by computer, including... [those geared] to presentation of textual material").

Rather, Khan's challenge to the sufficiency of the evidence supporting the Board's prima facie case is directed at the motivation to apply the teachings of Stanton to achieve the claimed invention. In the 1995 decision, the Board found that Stanton "teaches the benefit of acoustic imaging in reading systems." The Board carefully examined the Anderson/Garwin combination and recognized that a skilled artisan confronted with the problem faced by Kahn would have been led by the teaching of Stanton "to add advantageous acoustic imaging "to the Anderson/Garwin combination so that it would have "word positions acoustically and visually indicated."

Stanton teaches that "[its] invention relates to augmentation of vision of those who have lost vision or have

had their visual faculties diminished," col.1,ll.6-8,that it is "useful in teaching a deprivee to apprehend the position of a virtual sound source as representing a point in space," id., ll. 58-59, and that it may be used as a "rudimentary reading device," id., ll. 61-62. A skilled artisan, who knows of a "learning machine "that is capable of reading a word aloud by selecting the word on the screen at which the user is looking and seeks to provide a visually-impaired user better control over word localization,[4] would have reason to solve that problem by adding two-dimensional sound in view of Stanton's express teaching that two-dimensional sound can be used to "substitute" for the lost sense of sight, to locate a point in space, and to create a "rudimentary reading device" for the visually impaired. See Cross Med. Prods., 424 F.3d at 1323 (holding that "[o]ne of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings"). Because the Board need only establish motivation to combine by a preponderance of

[4]. Kahn does not argue that one of ordinary skill in the art at the time of the invention would be unaware of the nature of this problem, and there is nothing in the record to suggest this to be the case, unlike the facts in the decision of our predecessor court in In re Spinnoble, 405 f.2d 578 (C.C.P.A. 1969).

the evidence to make its prima facie case, see In re Glaug, 283 F.3d 1335, 1338 (Fed. Cir. 2002), we conclude that substantial evidence supports the finding of a motivation to combine the teachings of Stanton to the Anderson/Garwin combination. Although a reasonable person might reach the opposite conclusion, there is far more than a "mere scintilla" of evidence present from which a reasonable mind could find a motivation to combine.

We reject Khan's argument that the Board overstated the knowledge of the person having ordinary skill in the art or employed improper hindsight in making its prima facie case. In both Lee and Rouffet, the Board recognized that the knowledge of the skilled artisan could provide the motivation to combine but concluded that no such knowledge was articulated and placed on the record. Lee, 277 F.3d at 1343-45; Rouffet, 149 F.3d at 1357-59. In this case, motivation to combine was articulated and placed on the record. As to the Anderson/Garwin combination, the Board identified the desire to free up the hands of the Anderson user as the problem confronted and found that Garwin itself evidenced the broad applicability of its optical controls to the claimed invention. As to the addition of Stanton, the Board identified

express teachings in Stanton of "the benefit of acoustic imaging in reading systems" and properly related those teachings to the Anderson/Garwin combination.

We find Khan's remaining arguments unpersuasive. First, even if applying Stanton to Garwin resulted in a device that would be less effective for the purpose intended by Garwin, the teaching of the Garwin reference is not limited to the specific invention disclosed. See In re Heck, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (explaining that "[t]he use of patents as references is not limited to what the patentees describe as their own inventions" (internal quotations omitted)). As noted above, Garwin states that his invention is intended to be applied to "virtually [any device] susceptible of control by a computer, including. . . [those geared] to presentation of textual material," Garwin, col. 2, ll. 50-53; col. 10, ll. 31-35. Second, although Khan may have envisioned something different than the skilled artisan when he looked at Stanton because Stanton teaches only a rudimentary reading device, the skilled artisan need not be motivated to combine Stanton for the same reason contemplated by Khan. See In re Beattie, 974 F.2d 1309, 1312 (Fed. Cir. 1992) ("As long as some motivation or

suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor." (citing In re Kronig, 539 F.2d 1300, 1304 (C.C.P.A.1976))). Third, Khan's argument that Stanton itself teaches away from the combination with Garwin lacks support in the reference. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurlev, 27 F.3d 551, 553 (Fed.Cir.1994) Nothing in Stanton can be said to discourage a person having ordinary skill in the art from using the visual–input control taught in Garwin in the claimed combination or to lead the skilled artisan in a direction divergent from the path taken by Kahn.

Finally, we note that Kahn had an opportunity to rebut the Board's prima facie case by offering evidence of objective indicia of non-obviousness. Khan put on no evidence, but invites this court to take "judicial notice" of the long felt but unresolved need for a device that will help the blind read. We must decline Khan's invitation for the following reasons.

First, "long-felt but unresolved need" is not the kind of undisputed fact to which courts are accustomed to taking "judicial notice" because a finding either way can "reasonably be questioned." See Fed. R. Evid. 201(b) ("A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."); In re Fielder, 471 F.2d 640, 642-43 (C.C.P.A.1973) (declining judicial notice of prior art references that appellant submitted as objective evidence of non-obviousness because appellant did not offer references to the Board and they were not part of the record). Second, our precedent requires that the applicant submit actual evidence of long-felt need, as opposed to argument. This is because "[a]bsent a showing of long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness." Iron Grip Barbell Co. v. USA Sports, Inc., 392 F.3d 1317, 1325 (Fed. Cir. 2004); accord In re Wright, 569 F.2d 1124, 1127(CC.P.A.1977).

III CONCLUSION

Because the factual findings underlying the Board's analysis, including the findings on motivation to combine, are supported by substantial evidence, we conclude that the Board did not err in rejecting claims 1-20 as prima facie obvious. Because Khan did not rebut the Board's prima facie case, the Board's decision is

AFFIRMED.

Appendix B - Decision of the United States Court of Appeals for the Federal Circuit, Dated May 31, 2006

United States Court of Appeals for the Federal Circuit

04-1616

IN RE LEONARD R. KAHN

DECIDED: May 31, 2006

Appellant's motion for leave to file amicus brief en banc is

DENIED.

Appellant's Motion for Rehearing en banc is

DENIED.

Appendix C – Motion for Leave to File an Amicus Brief *En Banc*, Dated May 17, 2006 [Pages 35a – 37a]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

)
In Re Kahn) Appeal No. 04-1616
_____)

MOTION FOR LEAVE TO FILE AN
AMICUS BRIEF *EN BANC*

Introduction and Background

Amicus Curiae, Robert F. Dall, timely moved (at the Court on 5/12/06) to file an Amicus Brief because he, as expert, provided evidence in view of his many years of leadership at the Guiding Eyes For The Blind, to assist the Court in this case. He planned to support the Appellant. Appellant Kahn, now respectfully moves for the voting members of the *En Banc* Court to reconsider this Motion for Reconsideration of the Panel's decision, which did not provide a reason for denial, just as it did not in denying Kahn an Oral Hearing.

It is clear from the Opinion and from publications by scholars that critically commented on this 04-1616 Appeal that the key question that controls this 17 year old case is: Is

there a *long-felt* need for the subject reading machine for the blind. And now the very Panel that anchored its decision on its finding there was no proof and refused to take Judicial Notice is now denying proof from a real expert who has devoted over 25 years of his life to help the Blind and now this Court.

ARGUMENT

Amicus Curiae, Robert F. Dall, whose Certificate of Interest makes it abundantly clear that he has no interest in this case except to help his friends and clients, the Blind, and wishes to answer the very question the Panel used to deny Kahn a patent after 17 years of PTO delay and internal bickering.[1]

---

[1] Kahn wishes to stress the fact that he never petitioned the PANEL for a Rehearing as he believed that Judge Linn may wish to consider recusal as he made a key decision on Kahn's first Motion to grant him a priority date of 1989m bit 1996 as the Solicitor argued, a loss of 7 years. And this led to the PTO's flawed 2 ½ year argument that Kahn was not entitled to the 1989 priority and mocked Kahn for even asking to use an old "abandoned" application. Especially difficult to accept the Judge's 22 page Opinion (3/22/06) which failed to even comment of Kahn's Request for Sanctions re his years of difficult and expensive and useless Motion Practice. Please note that Kahn only petitioned for *En Banc* Rehearing.. Not by Panel, but it ruled. **This completes three strikes Catch 22 situation, 1) The Board decides *sua sponte* obviousness, 2)**

> "I respectfully request this Honorable Court to consider my above stated facts and opinions and to take Judicial Notice that, if the subject invention functions as claimed and can be massed produced at a price that permits the blind to make use of said machines, it most certainly satisfies a long felt need."

CONCLUSION

The mover respectfully requests this Honorable Court to grant this Motion and prays that this *En Banc* Court will grant Kahn his Constitutional Right of Due Process by permitting all of the members of this *En Banc* Court to hear and consider Mr. Dall's expert advice.

Dated: May 17, 2006

Respectfully

Leonard R. Kahn
Appellant, *pro se*
Registration No, 26,920
767 3rd Ave. 35th Floor
New York, New York 10017
Phone (212) 983-6765

No exam by official examiner, 3) Panel Denies *Amicus* Motion = No "*long-felt need*" Expert Evidence!

Appendix D – Petition for Rehearing *En Banc*, Dated May 2, 2006 [Pages 38a – 62a]

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

04-1616

(Serial No. 08/773,282)

IN RE LEONARD R. KAHN

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

PEITION FOR REHEARING *EN BANC*

Dated: May 2, 2006

Leonard R. Kahn
Registration No. 26,920
Applicant, Appellant, *pro se*
137 East 36th Street, 6A
New York, New York 10016
Office Phone (212) 983-6765

CERTIFICATE OF INTEREST

The Appellant Leonard R. Kahn certifies the following:

1. That he is acting *pro se* in representing his personal interest as the owner of all patent rights to the subject patent application.
2. That the firm which he is president and sole stockholder, Kahn Communications, Inc., does not own an interest in the subject application.
3. Kahn Communications, Inc. does not have any subsidiaries or parent companies.
4. No other patent agents or attorneys have or are expected to appear for me, personally.

Leonard R. Kahn, *pro se*
Registration No. 26,920
Appellant

Appendix D
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Dennis Crouch, *In re Kahn* blog patenlaw.typepad.com 1, 3 12, 13

J.S. Goetz *An "Obvious" Misunderstanding" Zurko, Lee and the Death of Official Notice* JPOS Vol. 86, 2 Vol. 86, 3 2004 .....1, 3

Judge Giles Rich *Laying the Ghost of the "Invention" Requirement* 1 APLA Q.J. 26-45 (1972) 1, 13

INTRODUCTION

This case is of "exceptional importance" as the panel decision is contrary to the *Lee & Ruiz hindsight* decisions of this Honorable Court and the *Graham* (1966) & *Zurko* (1999) U.S. Supreme Court controlling cases. Furthermore, this is a "Case of First Impression," as never before has this Court considered a case where a panel so clearly ignored Rule of Evidence 201 by refusing to take Judicial Notice, to thus violate the very essence of *Zurko* and the Administrative Procedure Act, (APA).

The importance of the instant opinion is underscored by scholar Prof. Crouch, from the Univ. of Chicago, blog (detailed *infra*) stated:

> *In re Kahn (Fed. Cir. 2006, 04-1616)*
> *I already provided a summary of this March 22, 2006 opinion, but decided that the meat of the opinion is important enough to be repeated....* Followed by three page analysis which included:

The words of Judge Giles Rich, who pioneered the use of secondary conditions to guard against

hindsight attacks on the patent law.

Also a PTO insider, John S. Goetz, forecasts that if the Federal Circuit continues down its present path trade secrets will render it and PTO *tall proud and empty*. (Please see pages 3 & 4, *infra*, footnote 2)

ARGUMENT

As a result of the Panel's Opinion, an invention, now 17 years old, which allows the blind to "read" so efficiently as to permit them to compete with sighted people and an invention that replaces the mouse with a faster, efficient interface with computers, has been ruled note to satisfy a *long standing need.*

The strangeness of the result, is underscored by the strange combination of four cited patents that either teach away from the subject invention or would never motivate an artisan to combine the PTO's cited closet prior are publications. Indeed, since all four cited patents' parent application were filed in 1979, some 26 years ago and since all

disclosed far older publication, the tools required to practice the invention were available for well over a quarter of a century, as argued *infra*, for almost a half a century.[1]

Thus, what is believed to be manifestly true is that the Court should take judicial notice that there is a long-felt need for helping the blind to read, reread, edit and indeed write scholarly documents such as legal and scientific publications. And there is no question that IBM has had a long felt desire to replace the mouse with a faster and more user friendly human/computer interface. And that IBM and indeed, the entire computer industry, had this need from the very day the mouse was invented in 1964, some 42 years ago.

Before detailing the response to the Panel's Opinion, the Appellant wishes to refer to one of the

---

[1] Two of these skilled inventors, Garwin & Levine, worked for IBM, a firm that is noted for its aggressive use of patents and therefore might be expected to be aware of any significant development based on computers, although Kahn cannot offer any supporting evidence.

last sections of this argument entitled: "The Administrative Procedure Act Saves This Case." As the Court will note that section provides a comprehensive analysis of the Standard of Review, (Opinion pg. 10), wherein the paper of Prof. Crouch, a highly respected patent attorney, specifically writing about the instant appeal argues the controlling effect of Judge Newman's *In Re Lee* Opinion:

> [T]*here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness....This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in §103.*

It should also be stressed that the Supreme Court, in a case controlling *ex parte* patent appeals, *Dickson v. Zurko* 527 U.S. 150(1999) specifically held that the APA controls the PTO and the Federal Circuit in *ex parte* patent cases....and that neither body can use *substantial evidence* logic to support a

refusal to issue a patent.[2] that when the Board made its sua sponte §103 *arbitrary and capricious* obviousness rejections, Kahn could (should) have stood moot...Roughly analogous to a putative criminal not offering evidence if he believes his guilt has not been proven beyond a reasonable doubt.

Kahn in teaching elements of probability theory to Electrical Engineering graduate students found the following puzzle a good illustration of why truly gifted mathematicians will first try inductive solutions before they jump into normal

---

[2] In *Finding Motivation, Teaching, or Suggestion in the Prior Art* H.R. Brown III argues that the PTO erred because of *"insidious hindsight syndrome,"* quoting the words originated by Judge Markey: *[W]here the invention is less technologically complex...the very ease with which the invention can be understood may prompt one "to fall victim to insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."* In *W.L. Gore v. Garlock 220* USPQ 303 (Fed. Cir. 1983)

J.S. Goetz two part study: *An "Obvious" Misunderstanding* with an inside PTO view concludes with a somber note: *[P]erhaps...the Patent Office and Federal Circuit, standing tall, proud and empty-because the guild system has surpassed the patent system in both timeless and surety.*

lengthy and complex analytical procedures. Puzzle: A tennis club wishes to schedule its annual tennis championship matches. There are 500 members. The question is: How many matches must they schedule? Once the answer is known, hind-sight will never allow you to recognize the beauty and originality of this example of highly respected, mathematical innovative reasoning.

The answer is 499 games as each member has to lose once, except the champion. The individual steps of the instant invention are most complex, but old 1989 technology, and if one uses 20/20 HINDSIGHT knowledge it is simple (obvious) to join all four of these complex steps.

Controlling Issues Of the Instant Appeal

Following the logic of *In Re Lee* and *Dickson v. Zurko,* three key issues would appear to logically control this decision, on of which is a "CATCH 22" procedural problem. Treating the non-procedural issues first: No skilled or lay person would question the fact that an invention that permits a totally blind

individual to read, edit and even write learned documents, such a legal briefs and scientific papers, and also permits normal users to increase their efficiency in interfacing with computers, satisfies a *long felt need.*

The second non-procedural issue is, as will be detailed below, that all of the prior art patents cited by the Board either *teach away* from the subject invention, or are completely devoid of *motivation to so combine* them, absent 20/20 hindsight.

Pleading in the alternative: Even if one ignores the Administrative Procedure Act, (APA), the key and controlling substantive finding in the instant decision is the Panel's refusal to take "judicial notice" that there was (and is) a *long-felt need* for the instant invention, when its parent application was duly filed in 1989, now (finally) admitted by the PTO.

Another fact which the Panel Accepted permits Kahn to demonstrate why one of the PTO's main arguments is manifestly illogical:

Appendix D
Petition for Rehearing *En Banc*

> *In its 1995 decision, after reversing the examiner's anticipation rejection, the Board sua sponte rejected the relevant claims under § 103. The Board found that Garwin taught "the concepts of determining where on a display screen a user is 'looking' . . . and giving either visual or auditory feedback. " and that " [w]hile nothing specific is said as to acoustically reproducing a word displayed at that location,"* Opinion page 6

Thus, the obviousness § 103 Decision was initially made by the Board, not the assigned Patent Examiner, an experienced individual in the relevant arts. And therefore the Examiner could not overrule the Board, no matter what evidence Kahn would offer. There was no way the examiner could change the Board's decision on obviousness. Thus, after reversing the first Examiner's § 102 rejection, the Board should have sent the case back to the new Examiner to determine, whether or not the invention is obvious under § 103, and not act as judge and jury.

This would have permitted Kahn to convince the Examiner that claims 1 to 20 were not obvious, and if Kahn succeeded he would have, assuming that Kahn

complied with all other requirements (as the Board apparently found) a patent would have issued.

This would have shifted the burden to other (commercial) parties, who might wish to challenge such a valuable patent. For the PTO to argue that there was no proof of "*long felt need*" violates common sense, and for the PTO to use its own flawed procedures represents a CATCH 22 situation which denied Kahn a valid patent, mocking Due Process.

The Court having found Kahn's invention obvious solely under § 103 resolves any doubt that, as of Apr. 1989, one could have built a machine that would permit the blind to compete with people with normal vision in editing and writing serious documents and permitting the computer industry to replace the mouse with vastly superior technology.

Furthermore, since one of the key advantages of the subject invention is that it replaces the mouse with a vastly superior human/computer interface, we can consider whether that device's conception in 1964, sets the "*long standing need*" to at least 40 years. Surely the

Court can take judicial notice that eye control is superior to dragging a mouse.

But even if a superior mouse had been available it would not have permitted the blind to compete. It also required the virtual sound display of text so that the blind would know where to look for the words he or she wished to read or reread to study or edit. The point is that the tools required to make the instant invention work and the basic need for this invention has existed for almost a half a century.

The PTO Failed To Show Motivation To Select

First recalling that *in re Lee* 61 USPQ2d 1430 ruled that:

> *This Court FORBIDS the use of hidsight in the selection of references that comprise the case of obviousness.* (Emphasis added) And one of the main factual findings required by *In Re Lee* at 61 USPQ2d at 1433 is : [T]*here must be some motivation suggestion or teaching of the desirability of making the specific combination that was made by the applicant.*

It is clear that these 4 cited patents, absent hindsight, would have never been selected by an individual of

ordinary skill in the relevant art, because the patents teach away from the subject invention and do not provide any motivation to combine them.

Consider the combining of sound with the IBM Garwin & Levine '990: Anyone who plays golf or, more to the point, goes to firing ranges to engage in marksmanship contests, will wear a hearing protector, no only to avoid hearing loss, but to avoid being distracted by people coughing, horns, etc. That a fighter pilot would want to "augment" his '990 control while launching a missile to save his life, is incredible.[3] Surely, Mr. Anderson and Mr. Fisher, skilled researchers of aids to the visually disadvantaged, with expert knowledge of their own '286 application filed in 1979, which is parent to both their '626 and '533 patents would have been *motivated* to take in, over a quarter of a century, this putative "obvious" step to permit totally

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[3] This is not to say that other inventions that may save pilot lives cannot be developed. But they were not conceived or made obvious by the '990 invention. See Kahn 6,909,381 which uses sound to avoid missiles, applied for in 2000, and therefore is not prior art for the instant case.

blind people to compete in the marketplace.

The Second Key Cited Patent Is Even Worse

The second key patent relied upon by the PTO to prove its case of obviousness is the Stanton 4,322,744 *Virtual Sound System For The Visually Handicapped.* Mr. Stanton's goal is, using 4 speakers to provide a device to help the blind to use sound to "see" simple shapes, navigate through their homes and even streets by using sound reflections, etc. And to act as a "*rudimentary reading machine.*" Just how rudimentary will now be demonstrated. The totally blind are the most important users, by far, of the '744 Patent and the instant invention. All other users from a social standpoint are of relatively little importance. Therefore, embodiments designed for the totally blind are only considered in the following. The '744 Patent does not use artificial or natural speech or any simulation of speech. It uses tones, noise pulses and varies their phase, intensity, waveshape, etc., for its real and important use; to help the totally blind hear reflections of sounds from the walls of their home and street sound reflections to

permit them to navigate. His R&D was clearly directed to serve the totally blind.

These '744 beautifully designed devices must be made as inexpensive and as small and portable as possible. They do not use any complex, expensive devices, such as devices to watch the user's eyes. Indeed, the invention calls for the totally blind user to stare dead-ahead whether they are using the four speaker display or the special earphones.

The user is then trained to use this miniaturized unit to identify simple shapes such as circles, rectangles and even letters ... from their basic SHAPES. May the Appellant respectfully request the reader to close his or her eyes for one second... Can one imagine how hard that would be for the blind to even read a three word message... And compare that with hearing entire words and phrases.

This is, of course, not to denigrate Mr. Stanton, his work is outstanding. It is not his fault that the Board and the Solicitor have continued for over 17 years to offer this specious argument.

The Real Question Is: Is There A Need For A Super-Mouse That Provides A Vastly Superior Interface Between Man And The Computer And Which Both Totally Blind And Sighted People Can Use?

First, it should be stressed that the *tools* required to practice the invention are well known... The software required to generate the virtual two dimensional stereo acoustical display and the virtual visual pages of words and phrase, page turners, etc. And the means for detecting where the eyes of the blind user is "looking," assuming her muscles controlling the eye or some other body part that can move rapidly is functioning after training. The "gold" far exceeds that of Fort Knox, even if one can be so oblivious to social imperatives and just focuses on the money available in replacing the mouse.

The only remaining question is: Is there an entity that has the know-how and resourced to do the job? Yes, Microsoft, Intel, Dell and IBM...IBM has already done the hard remaining job.. Garwin & Levine's eye controlled precision missile launcher. So there is no need for the delay except the PTO's failure to follow *Lee, Zurko & Ruiz.*

When one compares the cited 4 patents the PTO combines to somehow make the instant invention obvious it becomes clear that the best operation of these prior art patents is a crude substitute for a mouse, not a "super-mouse" that would allow the blind to compete.

Forty years must be an unacceptably long time for someone with a disability that denies them the ability to earn a good living to wait for new technology. To be told that, when they are 20 years old, that when they will be 60 years old they will still be waiting for that device, must be a shattering experience. The question must be raised, why doesn't the PTO understand that such an obvious long term need must be satisfied? And if the social need is ignored, what about the huge economic need for reducing the waste people suffer all over the world by using the clumsy, and slow operating mouse?

Part of this arcane type of obviousness analysis is the lack of appreciation of the importance of patent property in advancing the American economy. The first issue in considering the importance of recognizing why

this new major step in computer technology is so capital demanding. The reason should be clear; generations of computer users have grown up using the mouse. To change such a long term habit will take ah huge marketing program if the new technology is to be priced so that the device can be used by the blind and by normal users. And, of course, that means enjoying the savings of mass production.. selling at least tens of millions of mouse free computers.

The Administrative Procedure Act Saves This Case

After 17 years of intense study of this case, Kahn, in preparing this *en banc* petition read a detailed analysis of the Court's Opinion by Professor Crouch, through the blog patentlaw.typepad.com. In less than 3 pages Kahn learned how patent prosecution has been radically changed since the days he was admitted to the Patent Bar. Actually, it was just one sentence, derived from the most important name in intellectual property jurisprudence, Judge Giles Rich who wrote:

[Secondary consideration] *may also serve to guard against slipping into use of hindsight, and to resist the*

temptation to read into the prior art the teachings of the invention in issue by requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight in all cases-whether or not the applicant offers evidence on secondary considerations...Can any living scholar say it clearer?

After reading and rereading, (a key ingredient in understanding the instant invention), Kahn in preparing the initial draft of this brief recognized the importance of the Prof. Crouch & Judge Giles Rich "check-mate" argument.

To make certain that I actually understood the impact on the case, I considered the following analogy: The New York Yankees cannot score a run when the Washington Nationals are batting. The PTO (Yankees) cannot invoke the "secondary considerations" of proof of obviousness as taught in *Graham,* ONLY the Applicant (Nationals) can raise them, after the PTO has at least scored a run with its (the PTO's) *rational underpinning to support the legal conclusion of obviousness.* If the game ends without the PTO making at least one run by proving its prima facie case, it MUST issue the Patent.

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In the instant Opinion the Panel admits (page 10 under *Standards of Review*) that it can use more than *a mere scintilla of evidence* as taught by a 1936 case, and notes *the possibility of drawing two inconsistent conclusions from the evidence does not prevent the Board's findings from being supported by substantial evidence.* The Panel did not follow modern law and APA, as required by *Dickson v. Zurko.*

Thus, the PTO was not permitted to raise, what, as argued above, is a barrier as to *long felt need* that no inventor can reach. The PTO failed to provide Kahn logical reasons, why, he was not entitled to a patent.[4]

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[4] Furthermore, the PTO, having established such high application fees, and having made it necessary for Kahn to file 5 (five) CIPs (each with an application fee) because of the Board's unusual action of issuing a *sua sponte* §103 rejection and then engaging in a disagreement with the Examiner, had an even heavier duty to avoid violating the APA in making its final decision. When (if) the patent issues the public will soon determine if there is really *a long felt need* and if the mouse really needs a replacement, infringers will soon retest the obviousness question in a truly adversarial setting with attorneys who are paid by the infringers, not by PTO lawyers, who in turn are paid by the inventors.

Kahn formally declares that any patent licenses he grants re the instant invention will be royalty free for all legally blind purchasers.

Another Real Difference...*Ex Parte* Or Adversaries

Normal litigation can use scintilla decisions, but not normal patent *ex parte* PTO cases. This is a key point which warrants careful analysis. First of all, adversary cases must be decided, one way or the other, even if an agency makes the decision. The PTO Board of an Examiner cannot say: It's too close to call. A scintilla of differences will do. However, scintilla differences will not do for *ex parte* patent application cases, as the PTO was established to grant patents and MUST, to satisfy the APA Act, provide real reasons for denying applicants their patents.

The APA does not permit the PTO to use scintilla, flip of the coin or gnats eye lash decisions, in hindsight determinations that would allow Administrative Boards to make arbitrary grants of patents to "worthy" applicants. They must follow the law, not be *arbitrary, capricious, abuse discretion or use unsupported evidence that can be seen to reach two* diametric opinions. The reason Kahn and potential blind users of the invention was denied a patent after 17 years should, and MUST.

(according to the APA), and Judge Rich, be clear and unequivocal.

CONCLUSION AND PRAYER

In view of the above, and since the Appellant truly believes the Panel violated the controlling law of the Federal Circuit *(In Re Lee)* and the United Stated Supreme Court, *(Zurko),* and Due Process, the Applicant respectfully requests this Honorable Court to grant this Petition.

Respectfully Submitted,

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